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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,076	07/27/2005	Heinz Hornung	2732-157	2799
6449 7590 12/10/2009 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER				
HAGEMAN, MARK				
ART UNIT		PAPER NUMBER		
3653				
NOTIFICATION DATE		DELIVERY MODE		
12/10/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

10/520,076

Applicant(s)

HORNUNG ET AL.

Examiner

Mark Hageman

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 14-18 is/are allowed.
- 6) ☒ Claim(s) 2-5 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/8)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 is indefinite as it embraces both a process and an apparatus. See MPEP 2173.05(p). Amending the claims to include the word providing after comprising would overcome this rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 12 "is directed neither a process nor a machine but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted to so as to set forth the statutory classes of invention in the alternative only. See MPEP 2173.05(p).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0779604 to Baudat in view of US 6,913,260 to Maier and WO 00/48138 to Bell. Baudat discloses a method for and machine (figure 1) capable of selecting at least one bank note fit for circulation, selecting at least one bank note unfit for circulation (c12 lines 13+), processing the selected bank notes by means of the bank note processing machine (c12 lines 13+), whereby data of at least one sensor are stored (c12 lines 50+); and defining at least one threshold value for the at least one sensor by evaluating the stored data of the at least one sensor (13 lines 10+). Baudat also discloses the definition of the at least one threshold value is effected by determining the threshold value (c11 lines 36+), bank notes fit for circulation and those unfit for circulation are processed separately or jointly (c12 lines 15+), the method is carried out for each kind of bank notes (c12 lines 15+), at least one further threshold value is defined for at least one of bank notes fit for circulation or those unfit for circulation (c11 lines 37+), the at least one threshold value is formed by a discriminant function (c12 lines 36+). Baudat does not disclose the selection of the fit bank note is based at least in part on the lack of soil, damage, or alien elements and the at least one further threshold value is defined for bank notes that are suitable for automatic cash dispensers or the definition of the at

least one threshold value is effected by selecting the threshold value from a plurality of pre-determined threshold values (c13 lines 10+). Maier discloses, and it is well known in the art, the selection of the fit bank note is based at least in part on the lack of soil, damage, or alien elements and the at least one further threshold value is defined for bank notes that are suitable for automatic cash dispensers (c2 lines 5+) in order to remove old bills from circulation (c1 lines 31+). Bell discloses the use of different predetermined threshold values (p4 lines 3+) in order to toggle there-between to prevent fraud. Furthermore examiner notes that using such predetermined values is less computationally intensive and can be achieved on simpler control systems.

It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to have modified Baudat to include, the selection of the fit bank note is based at least in part on the lack of soil, damage, or alien elements and the at least one further threshold value is defined for bank notes that are suitable for automatic cash dispensers, as taught by Maier and well known in the art, in order to remove old bills from circulation. It would have also been obvious to one of ordinary skill in the art at the time of applicants' invention to have used predetermined values, as taught by Bell to prevent fraud and enable the use of simpler, less expensive control components.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baudat in view of Maier and Bell as applied to claims 2-4 and 8-12 above, and further in view of US 7,044,463 to Brotherston. Baudat in view of Maier and Bell discloses all the claim limitations except bank notes fit for circulation and those unfit for circulation are

separated from each other by means of a separation card, the separation card being recognized during processing. Brotherston teaches that it is "usual to use a separator document to mark the beginning and end of a batch" in the context of sorting currency (c1 lines 10).

It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to have modified Baudat in view of Maier to include the use of a separator card, as taught by Brotherston," to mark the beginning and end of a batch."

Response to Arguments

7. Applicant's arguments with respect to claims 2-4 and 8-12 have been considered but are moot in view of the new ground(s) of rejection.

8. Claims 7 and 14-18 are allowed.

9. The following is an examiner's statement of reasons for allowance: the prior fails to anticipate or render obvious the idea of the defining the rate of fit or unfit banknotes when combined with the other claim limitations. This step is unique in this claimed combination as the criteria for rejection are by the set of banknotes fed to the machine. Thus for instance if 100 bank notes are used for instance and the fitness rate is set at 95% the threshold will be set such that the 5 bank notes least fit for circulation (out of the 100) provided would be rejected.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Hageman whose telephone number is (571) 272-3027. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653

MCH